

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 55

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

DAVID R. PACHOLOK

Junior Party,¹

HENRY H. HUTMACHER, JOHN E. WILL, JAMES YOUNGMAN,
PHILLIP D. LANE and MICHAEL V. BELL

Senior Party.²

Interference No. 103,830

FINAL HEARING: December 13, 2000

Before URYNOWICZ, MARTIN and LEE, Administrative Patent Judges.

URYNOWICZ, Administrative Patent Judge.

FINAL DECISION

The invention at issue in this interference relates to an apparatus and method for disabling a vehicle. The particular subject matter in issue is illustrated by counts 1 and 2 as follows:

Count 1

A vehicle disabling device capable of contacting a pursued vehicle, sending an electrical discharge therethrough, and disabling at least one electric system of a vehicle; the vehicle

¹ Application No. 08/367,581, filed January 3, 1995, now U.S. Patent No. 5,503,059, issued April 2, 1996.

² Application No. 08/273,560, filed July 11, 1994. Assignors to Jaycor.

disabling device including a platform and a disabling circuit mounted thereon; the vehicle disabling device further including:

- (a) the disabling circuit including a electromagnetic pulse generating device;
- (b) a positioning means for placing the vehicle disabling device under the pursued vehicle;
- (c) a discharge means for activating the vehicle disabling device under the pursued vehicle;
- (d) the discharge means providing sufficient power with low to moderate energy levels to disable only the pursued vehicle; and
- (e) a coupling means delivering the energy levels from the electromagnetic pulse generating device to the pursued vehicle.

Count 2

A method for disabling a first vehicle, comprising:

administering a discharge to an undercarriage of the first vehicle:

overloading at least one electronic engine control of the vehicle; and

causing failure of the at least one electronic engine control of the first vehicle.

The claims of the parties which correspond to the counts are as follows:

Count 1

Pacholok : Claims 1-45 and 53

Hutmacher et al. : Claims 1-12, 14-16 and 23

Count 2

Pacholok : Claims 46-52

Hutmacher et al. : Claims 17-22 and 24

Hutmacher et al. (Hutmacher) provoked this interference on July 19, 1996 by copying claim 1 of Pacholok in exact form as Hutmacher claim 23, by copying claim 46 of Pacholok in

broadened modified form as claim 24, and by requesting an interference with Pacholok. The interference was declared on May 2, 1997 with count 1 corresponding exactly to Pacholok claim 1 and Hutmacher claim 23, and with count 2 corresponding exactly to Hutmacher claim 24.

During the period set for filing preliminary motions, Pacholok filed a preliminary motion under 37 CFR § 1.633(a) for judgment on the grounds that Hutmacher's claims 1-12, 14-16 and 23 are unpatentable to Hutmacher under 35 U.S.C. §§ 101 and 112 (Paper No. 14). In that period, Hutmacher filed a preliminary motion under 37 CFR § 1.633(c)(4) to redefine the interfering subject matter by designating its claims 5-12, 14-16, 20 and 21 as not corresponding to either count 1 or count 2. In a Decision on Preliminary Motions dated June 7, 1999, the motion of Pacholok was granted only to the extent that Hutmacher claim 23 was found not supported by Hutmacher; the above motion of Hutmacher was deferred to final hearing.

Issues

In its brief, Pacholok presented the following issues:

1. Whether Pacholok was first to conceive the inventions defined in counts 1 and 2.
2. Whether Pacholok was first to reduce to practice the inventions defined in counts 1 and 2.

Hutmacher presented the following issues in its brief:

1. Whether the Administrative Patent Judge erred in holding that Hutmacher's specification fails to support its claim 23.
2. Whether Pacholok has proven a date of invention for count 1 earlier than the July 11, 1994 filing date of Hutmacher.
3. Whether Pacholok has proven a date of invention for count 2 earlier than the July 11, 1994 filing date of Hutmacher.

4. Whether Hutmacher's motion to redefine the interfering subject matter, which motion was deferred to final hearing, should be granted.

Pacholok's Record Re Priority

The junior party's record is to the following effect.

During December of 1992, Pacholok developed a first prototype pulser for stopping cars during a high speed chase. At about that time, a test was conducted wherein the pulser was connected by long leads and alligator clips to the underside of a stationary automobile. The vehicle's radio and alternator were disabled during the test but the engine operation was unaffected. Pacholok was not satisfied with the test results.

Pacholok wrote up an invention disclosure and submitted it to R. Winston Slater, a patent attorney, on December 30, 1992 (Exhibit pages B4-B12). Pacholok prepared an addendum to his disclosure and sent it to Slater on or about February 19, 1993 (Exhibit pages B22-B28). During February and March 1993, he completed assembly of a second pulser, and ran tests on March 13 and 17, 1993 in the presence of Mark Elliot, an electronics consultant and friend. The pulser permanently stalled a running engine on March 17. A copy of the results of each test was sent by fax to Slater on March 21, 1993 (Exhibit pages B29-B30) and Pacholok sent an updated invention disclosure entitled LOW-COST SIMPLIFIED CAR KILLER INVENTION DISCLOSURE to Slater on that same date (Exhibit pages B31-B32).

From April through August 1993, Pacholok worked toward miniaturizing his device so that a car could drive over the housing of the pulser. Pacholok finished a simplified and miniaturized model built from a storage container with a 100KV capacitor and a self-contained inverter, battery, voltage multiplier and a pull-chain switch to turn the unit on and off. The capacitor to car electrodes were stiff HV wire inserted into plastic tubes, and so allowed

adjustment of the height of the electrodes by sliding the wires up or down within the tubes. This unit was tested on a 1993 automobile in the period of April through May 1993 at the home of Pacholok's father in Sterling Heights, Michigan, by driving the car over the unit at about 10 MPH. The results were such that the car had to be towed away. Pacholok informed Slater that he developed a unit that stopped a car in motion and that it soon would be conceivable to mount the whole unit on the front of a police car and fire it off using compressed gas or a pyrotechnic charge so it could travel under the car being pursued and thereby terminate the pursuit.

In September and October 1993, Pacholok built a miniaturized pulser circuit. In November 1993, the circuit was tested in the presence of Slater and Charles Kuecker, a business partner, who was helping on the project. The car was somewhat disabled following a test at 55MPH. It became apparent to Pacholok that a much larger inverter/battery pack system would be needed to completely disable a vehicle at high speeds.

In the period of August through December 1994, Pacholok attempted to build a robust miniature high power inverter, continued efforts to miniaturize the HV multiplier and to obtain smaller energy storage capacitors and generators for testing susceptibility of automotive modules.

Pacholok came up with a wire isosceles triangle guide system of constant base (a police car bumper width) and progressively greater height (the distance from the bumper to the projectile as it travels under the car being pursued). He decided to control launching through use of radio frequency and purchased an RF link in October 1994. In the following month, he ordered a locktite output and Black Max for use in adhering electrical parts to the projectile and he joined the Tripoli Rocketry Association to be able to purchase rocket motors for the projectile. After considerable refinements and false starts, Pacholok tested a first launchable prototype

successfully in December 1994. The rocket powered, dual wire guided projectile went 75 feet and was about 4 to 5 inches off perfect track at this distance.

Opinion

Pacholok must prove its case by a preponderance of the evidence where, as here, its application for patent was co-pending with the involved application of Hutmacher. Davis v. Reddy, 620 F.2d 885, 888, 205 USPQ 1065, 1068 (CCPA 1980).

We are of the opinion that Pacholok has not established an actual reduction to practice of the subject matter of either count at any time prior to its filing date.³

Even assuming for the sake of argument that the apparatus and method tested by Pacholok in his first three tests conducted in December 1992, March 1993, and April through May 1993 satisfy all the limitations of the counts, they fail to constitute an actual reduction to practice because the subject matter was not tested sufficiently to ensure that it actually worked for an intended purpose. Cooper v. Goldfarb, 154 F.3d 1321, 1327, 47 USPQ2d 1896, 1901 (Fed. Cir. 1998); DSL Dynamic Sciences Ltd. v. Union Switch & Signal, 928 F.2d 1122, 1125, 18 USPQ2d 1152, 1154 (Fed. Cir. 1991). This requirement must be satisfied even when the intended purpose is not explicitly set forth in a count (here, count 2) of the interference. Koval v. Bodenschatz, 463 F.2d 442, 447, 174 USPQ 451, 455 (CCPA 1972); Elmore v. Schmitt, 278 F.2d 510, 512-13, 125 USPQ 653, 655, (CCPA 1960); Burns v. Curtis, 172 F.2d 588, 590-91, 80 USPQ 587, 588 (CCPA 1949); Gordon v. Hubbard, 347 F.2d 1001, 1006, 146 USPQ 303, 307 (CCPA 1965). It is clear from Pacholok's disclosure that his intended purpose was to disable a pursued vehicle. Such a vehicle would be expected to be traveling at a relatively high

³ We assume, without finding, that the junior party established conception of the subject matter of counts 1 and 2 prior to the senior party's filing date.

speed, e.g., 55 miles per hour, and there is no evidence that the junior party stopped a vehicle traveling at a high speed any time prior to its test in November 1993.

The following other deficiencies exist with respect to individual tests.

With respect to the test made in December 1992, there is simply no independent corroboration of the test made by Pacholok. George William Wolf IV, who the inventor alleges witnessed the test, was not called by the junior party as a witness,⁴ and the only corroborating witnesses, R. Winston Slater and Mark Elliott, did not witness this test. There is no independent evidence that the parts evidenced by the inventor's receipts identified as Exhibit pages B1-B3 were used in the alleged testing. In order to establish an actual reduction to practice, an inventor's testimony must be corroborated by independent evidence. Cooper v. Goldfarb, 154 F.3d at 1321, 47 USPQ2d at 1896.⁵

Not only is the above December test uncorroborated, but at paragraph 5 of his testimony, the inventor testified that he was not satisfied with the test results. There must be recognition and appreciation that the tests were successful for reduction to practice to occur. Cooper v. Goldfarb, 154 F.3d at 1330, 47 USPQ at 1903.

As to the tests made in March 1993, Mark Elliott, the sole corroborator who witnessed the test, indicated that the vehicles tested were not moving. According to the testimony of the inventor, the pulser was connected to the engine and body of the vehicle with alligator clips, which clips could be expected to provide a secure, low impedance connection between the pulser

⁴ Paragraph 75 of the inventor's testimony indicates that Wolf was available as a witness for the junior party.

⁵ At the first paragraph of page 11 of its brief, the junior party in effect admits that it has not met the requirement of corroborated testimony with respect to this test.

and the engine and vehicle body. However, such clips are clearly not practical for use as connector electrodes to disable a moving vehicle. Pacholok contemplated HV wire electrodes providing arcing contact to the vehicle parts (Pacholok's testimony at paragraph 20; Pacholok's patent, column 7, lines 10-15). Such contact electrodes would logically have been expected to provide a relatively high impedance path to the vehicle, such that Pacholok's pulser may well have been unable to deliver sufficient power to disable the vehicles tested when moving.

Pacholok's testimony that he disabled a 1993 vehicle moving at 10 MPH in the period April-May 1993 is simply uncorroborated by any independent evidence and, accordingly, the junior party has not established an actual reduction to practice at that time. Furthermore, 10 MPH does not represent the speed of a pursued vehicle.

The last example of testing relied on by the junior party to establish actual reduction to practice prior to Hutmacher's filing date allegedly occurred in November 1993. Although Pacholok testified that the test was made in the presence of R. Winston Slater and Charles Kuecker, Kuecker did not testify in this case and Slater's testimony is silent with respect to his presence at the test. Thus, there is no independent evidence from Kuecker or Slater corroborating Pacholok's testimony with respect to this alleged test. Nor is there any other independent evidence tending to corroborate Pacholok's testimony as to the test. Accordingly, even though the inventor's testimony indicates the test achieved his goal of slowing down a moving vehicle by disabling its electronics, this evidence is not corroborated and the alleged test does not establish an actual reduction to practice.

Lastly, Pacholok did not verify that at least one electronic system (count 1) or one electronic engine control (count 2) was caused to fail. It is reasonable that a vehicle was disabled

because a discharge caused a mechanical failure stemming from the overheating and cracking of one or more parts.

Pacholok's Diligence

The junior party contends it was diligent in the period from just prior to Hutmacher's entry into the field on July 11, 1994 to its filing date on January 3, 1995.

A party that seeks to establish reasonable diligence must account for the entire period during which diligence is required; that period commences from a time just prior to the senior party's date to the junior party's reduction to practice, either actual or constructive. Gould v. Schawlow, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966). Public policy favors early disclosure. Naber v. Cricchi, 567 F.2d 382, 385, n.5, 196 USPQ 294, 297, n.5 (CCPA 1977), cert. denied, 439 U.S. 826, 200 USPQ 64 (1978). During this period there must be "reasonably continuous activity." Burns v. Curtis, 172 F.2d 588, 591, 80 USPQ 587, 588-589 (CCPA 1949). Evidence which is of a general nature to the effect that work was continuous and which has little specificity as to dates and facts does not constitute the kind of evidence required to establish diligence in the critical period. Kendall v. Searles, 173 F.2d 986, 992-93, 81 USPQ 363, 368 (CCPA 1949).

We hold that Pacholok has not established reasonable diligence in the critical period. The only evidence tending to corroborate the inventor's testimony with respect to diligence are the documents identified as B60-B69. Exhibit B60 is dated January 4, 1994 and is well outside the period with which we are concerned. Exhibits B61-69 cover the period October 27, 1994 to December 2, 1994. Even assuming that the above exhibits establish diligence between

October 27, 1994 and December 2, 1994, this still leaves a period of over three months which is not accounted for between Hutmacher's entry into the field on July 11, 1994 and October 27, 1994. Burns v. Curtis, 172 F.2d at 588, 80 USPQ at 587.

In view of our findings above with respect to Pacholok's evidence, the senior party Hutmacher is entitled to prevail herein on the issue of priority of invention.

Correspondence of Hutmacher's Claims 5-12, 14-16, 20 and 21

The deferred motion of Hutmacher to redefine the interfering subject matter by designating its claims 5-12, 14-16, 20 and 21 as not corresponding to either count 1 or count 2 is dismissed as moot in view of our find above that party Hutmacher is the first to invent.

Patentability of Hutmacher Claim 23

Hutmacher contends that the Administrative Patent Judge erred in holding that Hutmacher claim 23 is unpatentable to Hutmacher under 35 U.S.C. § 112, first paragraph, because its specification does not support the claim and seeks to have that holding overruled. It is the senior party's position at page 14 of its brief that when its vehicle drives over a structure on a driving surface, the vehicle disabler is placed under the vehicle.

The burden of showing that an interlocutory order should be modified is on the party attacking the order. The abuse of discretion standard does not apply to this issue of patentability. 37 CFR § 1.655(a).

Hutmacher is incorrect to argue that In re Spina, 975 F.2d 854, 24 USPQ2d 1142 (Fed. Cir. 1992) is controlling here and that claim 23 should be construed in light of Pacholok's specification. Rather, 37 CFR § 1.633(a), which was amended April 21, 1995, controls this situation. The third sentence of the rule specifies that "[i]n deciding an issue raised in a motion filed under this paragraph (a), a claim will be construed in light of the specification of the

application or patent in which it appears." The above rule was upheld in Rowe v. Dror, 112 F.3d 473, 479 n.2, 42 USPQ2d 1550, 1554 n.2 (Fed. Cir. 1997).

We are of the opinion that Hutmacher does not support its claim 23 as required by 35 U.S.C. § 112, first paragraph, when read in light of its specification. At page 15, lines 1 and 2 of its brief, Hutmacher admits that the pursued vehicle of its disclosure is not an element of claim 23. We agree with this admission because the pursued vehicle is disclosed by Hutmacher as the disabled device, not a part of the vehicle disabling device. The only other structure of Hutmacher's disclosure that could possibly be the positioning means of the claimed vehicle disabling device is the ground or driving surface, and/or a support thereon or therein, over which the pursued vehicle is traveling, and on or in which vehicle disabling apparatus is fixed. However, none of the above road structure acts to provide the function of "placing the vehicle disabling device under the pursued vehicle." The ground or driving surface and any support associated therewith, are completely static or passive, such that they cannot place anything anywhere. We do not regard it reasonable to construe "a positioning means for placing . . ." as covering devices which simply hold the vehicle disabling device stationary in the road. Putting the disabling device in the road and hoping that the pursued vehicle will itself come over the top of the device is not the same as placing the disabling device under the pursued vehicle. The vehicle may never be positioned over the device.

The public would not be well-served if Hutmacher were granted claim 23 to an invention he did not make. Nor would the public be well-served by granting Hutmacher a patent with claim 23, intended by Hutmacher to define something other than what it truly says in plain English, and the veiled meaning of which the public could only ascertain by researching the complex prosecution history of its application.

Judgment

Judgment as to the subject matter of counts 1 and 2, the only counts, is hereby awarded to Henry H. Hutmacher, John E. Will, James Youngman, Phillip D. Lane and Michael V. Bell, the senior party. On the present record, the party Hutmacher is entitled to a patent with claims 1-12, 14-22 and 24; the party Hutmacher is not entitled to a patent with claim 23. The party Pacholok is not entitled to its patent with claims 1-53.

STANLEY M. URYNOWICZ, JR.)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
JAMESON LEE)	
Administrative Patent Judge)	

SMU:clm

URYNOWICZ, Administrative Patent Judge, additional views:

I agree with the decision of my colleagues to enter judgment on the issue of priority against all of junior party Pacholok's claims that correspond to counts 1 and 2, and I agree with Administrative Patent Judge Lee that Hutmacher's claim 23 is unpatentable under 35 U.S.C. § 112, first paragraph, on the ground that Hutmacher's disclosure fails to provide written description support for the claim's requirement that the vehicle disabling device include "a positioning means for placing the vehicle disabling device under the pursued vehicle."

Nevertheless, concerning the issue of the patentability of Hutmacher claim 23, it is disturbing that under the holding in Spina, the PTO, as represented by the primary examiner or the Board in an appeal under 35 U.S.C. § 134, would have had to interpret the copied claim in light of its originating disclosure when considering the claim's patentability, whereas under interference Rule 1.633(a), validated by the holding in Dror, the PTO, as represented by the Board, construes the same claim in light of the specification in which it appears. Conceivably, one approach might require a finding of claim patentability whereas the other approach might require a finding that the same claim is unpatentable.

STANLEY M. URYNOWICZ, JR.
Administrative Patent Judge

) BOARD OF PATENT
) APPEALS AND
) INTERFERENCES

SMU:clm

MARTIN, Administrative Patent Judge, concurring in part and dissenting in part.

For the reasons given by my colleagues, I concur in their decision to enter judgment on the issue of priority against all of junior party Pacholok's claims that correspond to Counts 1 and 2, i.e., claims 1-53.

However, I do not agree with their decision that Hutmacher's claim 23 is unpatentable under the written description requirement of 35 U.S.C. § 112, first paragraph, on the ground that Hutmacher's disclosure fails to provide written description support for the claim's requirement that the claimed vehicle disabling device include "(b) positioning means for placing the vehicle disabling device under the pursued vehicle."⁶ For the reasons given by my colleagues, we are required by 37 CFR § 1.633(a) and Rowe to construe the language in question in light of Hutmacher's disclosure. While I share Judge Urynowicz's concern that this leads to an apparently anomalous result, i.e., construing the claim in light of Pacholok's disclosure in an ex parte context under Spina versus construing it in light of Hutmacher's disclosure in an interference context under Rowe, that seems to be the import of those decisions.

Turning now to the facts, the only embodiments in Hutmacher which employ vehicle disabling apparatus located under a pursued vehicle are the embodiments of Figures 2-4, which

⁶ Pacholok has not briefed this issue for final hearing. As the prevailing party on this support issue, Pacholok properly omitted any discussion of this decision in its opening brief for final hearing, leaving it to Hutmacher to raise the issue in its brief, which Hutmacher did. See Patent Appeal and Interference Practice -- Notice of Final Rule, 60 Fed. Reg. 14,488, 14516 (March 17, 1995), reprinted in 1173 Off. Gaz. Pat. & Trademark Office 36, 60 (April 11, 1995) (explanatory notes on adoption of amended interference rules) :

In order to clarify that the opening brief of a junior party need not address the evidence of the other parties, § 1.656(b)(6), as adopted, is revised to require only that the junior party's opening brief contain the contentions of the party "with respect to the issues it is raising for consideration at final hearing." These issues would include the junior party's case-in-chief for priority with respect to an opponent or derivation by an opponent as well as matters raised in any denied or deferred motions of the junior party that are to be reviewed or considered at final hearing.

However, Pacholok failed to file a reply brief responding to Hutmacher's arguments for reversing the APJ's decision. This failure arguably could be construed as agreement with Hutmacher's contention that the decision should be reversed.

are stationary disabling devices. Contact wires 34 and 36 are supported in vertical positions in the road either by a mounting plate 30 (Figs. 2 and 3; Spec. at 9, lines 18-23; Spec. at 11, lines 8-11) or by the road itself, presumably by holes therein (Fig. 4; Spec. at 11, lines 16-23). It seems reasonable to me to consider the mounting plate or the holes in the road to constitute "positioning means for placing" the wires under the pursued vehicle, because in my view this language, when construed in light of only Hutmacher's disclosure, does not imply that the positioning means moves the vehicle disabling device relative to the road, as held by my colleagues.

I do not reach the question of whether the "vehicle disabling device" which is placed by the positioning means must include more than just Hutmacher's above-mentioned wires, as apparently argued in Pacholok's motion (Paper No. 14, para. VII). Specifically, the motion argues that whereas claim 23 recites means for placing, under a pursued vehicle, a disabling device comprising a platform supporting a disabling circuit which includes an electromagnetic pulse generator, Hutmacher discloses "plac[ing] the disabling circuit either on the ground away from the contacts which engage the pursued vehicle or within the confines of a pursuing vehicle." Hutmacher's opposition (Paper No. 21, at 15) characterizes this argument as meaning that the "positioning means" in claim 23 positions the entire disabling circuit under the pursued vehicle. However, claim 23 was not interpreted in this way by the Administrative Patent Judge in support of his decision granting the motion (Paper No. 36, at 4) and is not interpreted in this

Interference No. 103,830

way by either of my colleagues. As a result, I express no opinion on the merits of that interpretation.

JOHN C. MARTIN
Administrative Patent Judge

) BOARD OF PATENT
) APPEALS AND
) INTERFERENCES

JCM:clm

Interference No. 103,830

Attorney for Pacholok:
Mathew R.P. Perrone, Jr.
204 South Main St.
Algonquin, IL 60102-2639

Attorneys for Hutmacher et al.

Thomas F. Lebens
FITCH, EVEN, TABIN & FLANNERY
120 S. LaSalle St.
Suite 1600
Chicago, IL 60603